

discuss the type of input image used by Yair, an issue raised by Applicant, and ignores the fact that Yair has no disclosure or suggestion of, or even a need for, a user interface or a dedicated user interface, as recited as well as, other reasons presented by Applicant concerning improper motivation to combine Yair and Goldberg. The analysis in the Examiner's Answer also fails to logically rebut Applicant's argument argued that Yair's classification logic 220 is used to segment the unsegmented image input to the segmenter 140, and is not used to associate a segmentation classifier and at least one segment of the input segmented image. Moreover, the analysis in the Examiner's Answer merely repeats the rejection and never addresses the fact that the claimed invention recites an "input segmented image", whereas Yair inputs an unsegmented image.

With respect to the impropriety of combining Yair and Goldberg, the Examiner's Answer admits that Yair does not disclose an image processing tool association circuit corresponding to the image classifier. However, instead of addressing Applicant's arguments alleging lack of proper motivation to combine Yair and Goldberg, the Examiner's Answer merely parrots the rejection set forth in the Final Rejection, which provides the following motivation for modifying Yair in view of Goldberg: "[A]dvantageously, a toolbox of various analytical tools can be incorporated into the GUI-based image acquisition interface(emphasis added)".

Merely that the prior art can be modified in the manner suggested by the Final Rejection and the Examiner's Answer does not render the claimed invention obvious unless the prior art suggests the desirability of the modification. In re Fritch, 23 USPQ2d 1780, 1783-4 (Fed. Cir. 1992). A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusionary statements of the Examiner, In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Accordingly, the Final Rejection fails to make out a prima facie case of unpatentability of the claimed invention.

In the paragraph bridging pages 20 and 21, on page 21 and through the first full paragraph on page 22, the analysis in the Examiner's Answer fails to address Applicant's arguments regarding improper motivation to combine Yair, Goldberg and Marimont. Applicant's arguments in this regard are found on pages 23-25.

The motivation, set forth in the analysis provided by the Examiner's Answer's, for modifying Yair and Goldberg in view of Marimont fails to provide any desirability to make the modification, reaches the claimed invention solely on hindsight reconstruction of the claimed invention, and then bluntly asserts that Applicant's claimed invention would produce a desirable result. The analysis provided in the Examiner's Answer achieves the invention solely through hindsight.

As another example, in pages 24 and 25 of the Examiner's Answer fails to address the Applicant's arguments concerning improper motivation to combine the references (Yair, Goldberg and Lee) used in the rejection of Claims 7, 17 and 18. Instead, the analysis in the Examiner's Answer merely repeats the assertion that the resulting combination would be desirable. In other words, the analysis in the Examiner's Answer reaches the claimed invention solely on hindsight reconstruction of the claimed invention and then bluntly asserts that Applicant's claimed invention would produce a desirable result. This ignores the teachings of the prior art as a whole and improperly uses Applicant's invention against Applicant.

Furthermore, on pages 25-27 of the Examiner's Answer, the analysis in the Examiner's Answer fails to address Applicant's arguments that combining Mahoney with Yair and Goldberg is neither feasible nor desirable. Instead, the Examiner's Answer merely argues that Mahoney discloses a feature missing from Yair and Goldberg, yet while failing to provide absolutely any motivation to combine these references. Again, the Examiner's Answer then concludes that the reference combination, for which the analysis in the


Examiner's Answer fails to show proper motivation to achieve, provides desirable results.

This is a prime example of improper hindsight reconstruction of Applicant's claimed invention.

A fair, balanced appraisal of the Final Rejection and the Examiner's Answer reveals the failure of the base reference, Yair, taken alone or in any of the asserted reference combinations, to disclose all of the positively features of the invention, and of the complete failure of the Final Rejection and the Examiner's Answer to provide proper motivation to combine the references used in the reference combinations applied in the rejection of Applicant's claims, or to even address Applicant's arguments regarding improper motivation. Moreover, the Final Rejection and the Examiner's Answer merely combine the references in brute force fashion to provide features in the claims which are not found in a single reference without regard to providing proper motivation to combine the references. The Final Rejection and the Examiner's Answer then blithely conclude, after the references have been combined, that the reference combination provides a useful result (and parenthetically state that the useful result was the motivation to combine the references, when it is actually only the result of a combination that is only obvious based on Applicant's disclosure).

Accordingly, Applicant requests the Honorable Board to (1) reverse the rejections set forth in the office Action and (2) return the application to the Examiner to (a) consider U.S. Patent 5,802,203, which was supplied in an Information Disclosure Statement to the examiner but which the examiner has not considered on the merits, despite a number of requests to do so (including in the Examiner's Answer) and (b) pass this case to issue.

Respectfully submitted,



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